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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,095	09/09/2003	Varghese Devassy	4982/18	9961
29858	7590	02/24/2006	EXAMINER	
BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022				ELMORE, STEPHEN C
ART UNIT		PAPER NUMBER		
2185				

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/658,095	DEVASSY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Stephen Elmore	2185

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 September 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-35 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 12/15/03, 11/01/04, 10/11/05.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

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#### DETAILED ACTION

1. This Office action responds to the application filed 9 September 2003.
2. Claims 1-35 are presented for examination.

#### *Specification*

3. The disclosure is objected to because:

- a. it uses the terminologies "storage controller computer" and storage manager computer" only in context, fails to explicitly define the terms, and fails to explicitly differentiate how the scope of one apparatus term is structurally different from the other,

"While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). See MPEP 2114.

The claimed apparatus' "storage controller computer" and storage manager computer" disclosed in the Specification should be distinguished from the prior art in terms of structure rather than function, otherwise, in view of *In re Schreiber*, any prior art computer apparatus which performs the intended functionality attributed to these elements can be properly taken to meet the claimed limitations disclosed in the Specification.

**Appropriate correction is required.**

#### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because:

**Claims 1, 4-6, 9, 14, 16, 17, 18, 21-23, 25-27, 30, and 32-35,**

- a. inclusion of the term "storage controller computer" makes the claim indefinite because this is not a term in the art having a well-defined scope of meaning (as this term does not appear in a technical dictionary), and further, this term has not been explicitly defined in the claim or in the

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Specification, consequently, one of ordinary skill in the art would not comprehend the scope of coverage of this term, i.e., its metes and bounds;

**Claims 7, 10, 15, 18, 24, 26, 28, 29, and 33-35,**

b. inclusion of the term "storage manager computer" makes the claim indefinite because this is not a term in the art having a well-defined scope of meaning (as this term does not appear in a technical dictionary), and further, this term has not been explicitly defined in the claim or in the Specification, consequently, one of ordinary skill in the art would not comprehend the scope of coverage of this term, i.e., its metes and bounds;

**Claims 18, 26, and 33-35,**

c. inclusion of the terms "storage controller computer" and "storage manager computer" makes the claim indefinite because these are not terms in the art having well-defined scope of meaning (as these terms do not appear in a technical dictionary), and further, these terms have not been explicitly defined in the claim or in the Specification, consequently, one of ordinary skill in the art would not comprehend the scope of coverage of these terms, i.e., their metes and bounds, or how one term differs from another in scope of coverage;

d. Claims 2, 3, 8, 11-13, 19, 20, and 31 inherit the deficiency of the preceding claim in the claim dependency chain.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4-7, 13, 18, 21-24, and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Urevig et al., US 6,154,787 (Urevig).

In the following rejections, given the 112, second paragraph rejections *supra*, the terms "storage controller computer" and "storage manager computer" have been interpreted to be met by

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computer components which are interpreted as performing the claimed functionality. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). See MPEP 2114.

Urevig teaches the claimed method and system for dynamically allocating control of a storage device (claims 1 and 18), col. 3, lines 10-25, and col. 6, lines 26-52, comprising:

**Claim 1,**

- a. receiving a request from a first computer requesting access to a storage device, col. 9, lines 49-54;
- b. directing, based on the access request, a first storage controller computer to assume an inactive state with respect to control of the storage device, col. 10, lines 41-50;
- c. directing...a second storage controller to assume an active state with respect to control of the storage device, col. 10, lines 46-50;

**Claim 18,**

- d. a storage device for performing storage operations as directed by a storage controller computer, as shown by any of the elements of the device pool, U40, Figure 2;
- e. a first and a second storage controller computers programmed to direct storage operations performed by each of the respective storage devices, 102 and 104, and respective disclosures in the patent, where the programmed feature is inherent;
- f. a storage manager computer programmed...to direct a first storage controller computer to assume an inactive state...and to direct a second storage controller computer to assume an active state with respect to control of the storage device, col. 10, lines 41-50, STDM 160, where the programmed feature is inherent;

**Claims 4, 5, 21 and 22,**

- g. these limitations are inherently taught in the UNIX environment of the reference, as the activities mounting and demounting of the tape devices;

**Claims 6, 7, 23, and 24,**

- h. these limitations are taught to the extent as claimed, given the 112, second paragraph problems already mentioned;

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**Claims 13 and 31,**

i. the feature database is taught to the extent as claimed as inherent to the display, col. 5, line 61 - col. 6, line 9, and col. 6, lines 55-59, where the data structure representing the displayed drive status is equivalent to a database structure, and further taught, col. 9, lines 3-32, as a database data structure in-transition status indicating a change in status.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 3, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urevig et al., US 6,154,787 (Urevig).

Urevig teaches the claimed method and system for dynamically allocating control of a storage device (claims 1 and 18), as noted above, but, Urevig does not explicitly teach the limitations where the requesting access feature requests access to a backup device, or Urevig does not explicitly teach where the requesting access feature requests access via a storage area network, however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Urevig to incorporate these features into the method and system of dynamically allocating control of a storage device as taught by Urevig because it is notoriously well-known in the art to perform backup to tape devices and one would have been motivated to improve the usefulness of the system of Urevig to incorporate tape backups and because it would have been obvious to expand the

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functionality of the system of Urevig to SAN as suggested, col. 2, lines 25-35, because SAN data processing systems already having shared device configurations would benefit by incorporating the ability to share common equipment such as tape drives using the system of Urevig.

***Allowable Subject Matter***

10. Claims 8-12, 14-17, 25-30, and 32-35 appear to be allowable over the prior art of record if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

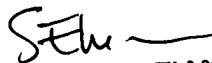
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Elmore whose telephone number is (571) 272-4436. The examiner can normally be reached on Mon-Fri from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 19, 2006

  
STEPHEN C. ELMORE  
PRIMARY EXAMINER